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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/857,181	06/19/2001	Octavian Anton	P66718US0	8973

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EXAMINER

NORDMEYER, PATRICIA L

ART UNIT	PAPER NUMBER
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1772

DATE MAILED: 01/20/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

207

Office Action Summary	Application No.	Applicant(s)	
	09/857,181	ANTON ET AL.	
	Examiner	Art Unit	
	Patricia L. Nordmeyer	1772	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 October 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 5-9 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 5-9 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other:

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DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on October 2, 2003 has been entered.

Response to Amendment

2. The declaration under 37 CFR 1.132 filed August 4, 2003 is insufficient to overcome the rejection of claims 5 and 6 based upon the 35 U.S.C. 103 rejection over Kratel et al. in view of Takahashi et al. as set forth in the last Office action because: The methods used in the declaration are more detailed to make the board than the method shown in the claim. The scope of declaration is narrower than the scope of the claim.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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4. Claims 5 and 6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kratel et al. (USPN 5,556,689) in view of Takahashi et al. (USPN 4,647,499).

Kratel et al. discloses a microporous heat insulating board that contains 30 to 100% by weight of finely divided metal oxide, 0 to 50% by weight of an opacifier, 0 to 15% of an organic binder and 0 to 50% by weight of a fibrous material (Column 4, claim 1). However, Kratel et al. fails to disclose 2 to 45% or 5 to 15% of xonotlite present in the heat insulating board.

Takahashi et al. teaches 2 to 60% (Column 7, lines 30 – 34) of xonotlite (Column 21, lines 59 – 61), 21 to 70% of an inactive substance (Column 5, lines 53 – 55) which includes metal oxides (Column 5, lines 31 – 40) and other additives such as fibers and binders (Column 7, lines 51 – 53) in an insulation board for the purpose of forming a board that is light weight, has excellent insulating properties over a wide range of temperatures and has high fire resistance.

It would have been obvious to one of ordinary skill in the art at the time the applicant's invention was made to have provided the xonotlite as a component in Kratel et al. in order to form a board that is light weight, has excellent insulating properties over a wide range of temperatures and has high fire resistance as taught by Takahashi et al.

Regarding the heat insulation bodies being manufactured by dry compressing in claim 1, the determination of patentability for a product-by-process claim is based on the product itself and not on the method of production. In this case, the limitation of dry compressing is a method

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of production and therefore does not determine the patentability of the product itself. Process limitations are given little or no patentable weight. The method of forming the product is not germane to the issue of patentability of the product itself. MPEP 2113.

5. Claims 7 – 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kratel et al. (USPN 5,556,689) in view of Takahashi et al. (USPN 4,647,499) as applied to claims 5 and 6 above, and further in view of Sklarski et al. (USPN 4,783,365).

Kratel et al., as modified with Takahashi et al., discloses the claimed invention above except for at least one or both sides of the core having a cover of a heat-resistant material, characterized in that the cover are the same or different and at least one side consists of pre-compressed xonotlite, mica or graphite, the cover consists of a prefabricated mica sheet on both surfaces.

Sklarski et al. teaches binder being impregnated in a mica paper or papers (Column 1, lines 47 – 52) before placed under heat and pressure (Column 6, lines 33 – 35) in a laminate for the purpose of forming a insulating structure with excellent flexibility, higher moisture resistance and more strength that can be used as supporting insulation for high temperature thermostats, control devices, strip heaters and baseboard heaters.

It would have been obvious to one of ordinary skill in the art at the time the applicant's invention was made to have provided a layer of mica sheets as cover sheets in the modified

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Kratel et al. in order to forming a insulating structure with excellent flexibility, higher moisture resistance and more strength that can be used as supporting insulation for high temperature thermostats, control devices, strip heaters and baseboard heaters as taught by Sklarski.

Response to Arguments

6. Applicant's arguments filed in Paper #10 regarding the 35 U.S.C. 103 rejection of claims 5 and 6 over Kratel et al. in view of Takahashi et al. have been fully considered but they are not persuasive.

In response to Applicant's argument that the present invention is manufactured by dry compressing, no weight is given to process limitation in the claim since it a product by process claim. The references, as disclosed, teach the structure of the claimed invention.

In response to Applicant's argument that Kratel et al. and Takahashi et al. does not include certain features of the Applicant's invention, the limitations on which the Applicant's relies (i.e. products containing pyrogenic silica crack upon drying when a wet formation is process is applied) are not stated in the claims. It is the claims that define the claimed invention, and it is claims, not specification that anticipated or unpatentable. *Constant v. Advanced Micro-Devices Inc.*, 7 USPQ 2d 1064.

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7. Applicant's arguments filed in Paper #10 regarding the 35 U.S.C. 103 rejection of claims 7 – 9 over Kratel et al. in view of Takahashi et al. and Sklarski et al. have been fully considered but they are not persuasive.

In response to Applicant's argument that Kratel et al. and Takahashi et al. does not include certain features of the Applicant's invention, the limitations on which the Applicant's relies (i.e. the binders in the heat insulation body being heat stable up to temperatures of 1000 °C) are not stated in the claims. It is the claims that define the claimed invention, and it is claims, not specification that anticipated or unpatentable. *Constant v. Advanced Micro-Devices Inc.*, 7 USPQ 2d 1064.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Patricia L. Nordmeyer whose telephone number is (571) 272-1496. The examiner can normally be reached on Mon.-Thurs. from 7:00-4:30 & alternate Fridays.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Harold Y. Pyon can be reached on (571) 272-1498. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (571) 272-0987.

Patricia L. Nordmeyer
Examiner
Art Unit 1772

pln
pln


HAROLD PYON
SUPERVISORY PATENT EXAMINER
1772

1/15/04